REMARKS

Status of this application

Claims 1-20 are pending. In the outstanding Office Action, claim 11 was objected to as containing an informality and claims 1-10 and 13-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al. (US 5,572,442), hereinafter Schulhof, in view of Ostrover et al. (US 6,026,446), hereinafter Ostrover. Claims 11 and 12 were indicated to be allowable if rewritten in independent form.

This response amends claim 11 to correct the informality noted by the Examiner, corrects a typographical error in claim 9, and requests reconsideration of the obviousness rejection of claims 1-10 and 13-20.

The Rejection under 35 U.S.C. §103(a)

In the discussion that follows, the Examiner's comments in paragraphs are reproduced below in italics, for convenient reference, and will be followed, where appropriate, by applicants' remarks.

5. As to claims 1 and 13, Schulhof discloses the invention substantially as claimed, including a method for selectively reproducing locally stored programming signals (col. 5, lines 52-67) comprising, in combination, the steps of

storing a first set of separate programming segments at a client location (50, fig. 1; col. 4, lines 57-63; col. 4, lines 30-32);

As noted by the Examiner, Schulhof's portable storage medium stores programming segments at a client location. Although Schulhof notes, at column 4, lines 30-32 that the prior art patent 4,381,522 describes "telephone selection of video programming for viewing on a cable television system in which a directory channel displays program selections and schedules," Schulhof does not suggest that the contents of a directory channel would or should be recorded at the client location. Schulhof does use a cable television system to broadcast a catalog of available audio programs (see col. 5, lines 5-20) from which the user selects programming that is downloaded into the local storage medium 50, but Schulhof nowhere suggests that the catalog itself would be

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downloaded and stored at the client location, and there is no reason to do so, since the catalog has already been displayed and uses to select the programming segments that are downloaded.

employing processing means to derive identification data from each of said first set of separate programming segments (col. 4, lines 63-64; col. 5, lines 5-8);

The cited passage at col. 4, lines 63-64 discloses "(3) a mobile control interface for displaying the identity of recorded material for playback selection." Although Schulhof does not state the source of the displayed "identity of recorded material," Applicants concede that such information might be derived from the programming segments recorded on the portable storage medium. However, as discussed below, there is no suggestion that such derived identification information is ever transmitted to the remote processing location, or used for any purpose other than to select recorded material for playback.

The further cited passage in Schulhof at col. 5, lines 5-8 discloses that "(1) the subscriber attaches the portable device to a cable television converter and selects a dedicated data exchange channel, e.g. Channel 66, that provides a menu display which includes a catalog of available audio program material;" As this passage makes clear, the catalog menu displayed to user is obtained from the data exchange channel and there is no suggestion that this menu is derived from the program segments stored at the client location as claimed, and no suggestion that selections made from the menu are derived from the program segments already stored at the client location as claimed.

transmitting said identification data from said client location to a remote processing location (col. 5, lines 9-12 and 52-53; col. 6, lines 31-39; col. 9, line 65 – col. 10, line 4),

The passages in Schulhof at col.5, lines 9-12 and 52-53 describe the manner in which the listener makes a selection from the provided catalog, and then sends the selection to the remote processing location. However, as discussed above, this selection

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is not "identification data" that is derived from the program segments stored at the client location as discussed above.

at said remote processing location comparing said identification data with a database containing identification information and associated content descriptions for each of a second set of programming segments (col. 10, line 35 – col. 11, line 15);

The cited passage at col. 10, line 35 to col. 11, line 15 describes the manner in which the Schulhof system processes incoming program selections. As noted above, however, the program selections which the Schulhof system processes are program selections derived from the broadcast catalog, and not from the program segments recorded at the client location.

It should be noted here that the Examiner did not quote the remainder of this clause of claim 1 which expressly states that the "comparing" step is performed "to identify common program segments found in both said first and said second set of programming segments." In paragraph 6, discussed below, the Examiner concedes that *"Schulhof does not specifically disclose common program segments found in both said first and said second set of programming segments."*

transmitting from said remote processing location to said client location selected ones of content descriptions stored in said database which describe said program segments (col. 6, lines 40-61; col. 10, lines 40-41), and

The cited passages in col. 6 and col. 10 both describe the manner in which "actual program material" is transmitted to the subscriber to fulfill the received program selection request. There is no suggestion in these cited passages that content descriptions stored in a database are sent, or that anything other than "actual program material" is sent.

It is further noted that the Examiner omitted the word "common" in the quoted phrase which reads:

> *"transmitting from said remote processing location to said client location selected ones of content descriptions stored in said database which describe said*

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common program segments, " (emphasis added)

In paragraph 6 of the Action, discussed next, the Examiner conceded that Schulhof does not disclose "common program segments" and nothing in the cited passages discloses or suggests transmitting content descriptions of common segments as claimed.

For the reasons presented above, applicants submit that Schulhof does not disclose the subject matter set forth in claim 1, even if the limitations regarding "common program segments" are ignored, as they were in the Examiner's explanation quoted above. Accordingly, even if the Schulhof system were modified using the teachings of Ostrover as the Examiner has proposed, the resulting system would still differ from the invention set forth in claim 1. These comments also apply to claim 7 which was rejected for the same reasons as claim 1.

6.   Schulhof does not specifically disclose common program segments found in both said first and said second set of programming segments. However, Ostrover discloses common program segments found in both said first and said second set of programming segments (col. 14, lines 35-54; col. 20, lines 44-47). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Schulhof and Ostrover because common program segments in Ostrover's would improve the mirroring contents of Schulhof's system by allowing users to redundantly record the common programs, thereby allowing seamless play to take place (Ostrover, col. 20, lines 44-47).

Ostrover, in the passages cited, discloses that two different versions of a program may be processed and stored as a combination of segments unique to each version and segments common to both versions. But, even if Schulhof's system were modified to store and supply programming content organized in that fashion, neither Schulhof nor Ostrover disclose or suggest comparing identification data derived from program segments stored at the client location with identification data in a database to identify common program segments stored at both the client location and the database, and neither reference suggests transmitting content descriptions which describe the common program segments thus identified from the remote site to the client site. Thus, even if the proposed modification were made, the result would not yield the invention as set forth in claim 1.

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Paragraphs 5 and 6 of the outstanding action discussed above reject independent claim 13, but do not discuss the specific limitations found in claim 13 that differ from the quoted limitations in claim 1. Reconsideration of the rejection of claim 13 is requested for the reasons expressed above for claim 1, but for the further reason that neither Schulhof nor Ostrover suggest or disclose "processing said broadcast signal at said client location to extract brief segments from the content of said broadcast signal," neither suggests or discloses "utilizing a communications channel to transmit said brief segments from said client location to a remote processing location," neither discloses or suggests "comparing said segments received from said client location with a library of previously recorded programs to identify particular programs which contain segments matching the segments received from said client location," and nether discloses or suggests "transmitting program guide data describing said particular programs to said client location from said remote programming location."

For the foregoing reasons, reconsideration of the rejection of independent claims 1 and 13 is requested, and allowance of those claims, as well as all of the remaining claims which are dependent thereon, is requested.

Several of the Examiner's further statements regarding recitations contained in dependent claims deserve comment, however, and those comments appear below following the Examiner's statements:

10.   *As to claim 5, Schulhof discloses the identification data contained in the database are derived from the broadcasted programming signals (col. 9, line 65 — col. 10, line 14).*

  Claim 5 states that "the identification data contained in said database are derived from said broadcasted programming signals received at said remote processing location concurrently with the reception and recording of said broadcast programming signals at said client location, and said content descriptions transmitted to said client location from said remote processing location are used at said client location to facilitate the selective time-shifted reproduction of said broadcast programming signals." Neither Schulhof nor Ostrover suggest or disclose a system in which broadcast program signals are stored

concurrently at both the client location and the remote processing location.

*11.   As to claim 6, Schulhof discloses specifying the beginning and end time of each of said
program segments (i.e., broadcast schedule; col. 6, lines 19-23).*

The cited passage states that Schulhof's "library may provide daily delivery of a
morning newspaper in audio format that allows a subscriber to listen to the news in a way
that the news is not interrupted by commercial breaks and is not truncated to fit into a
tight broadcast schedule." This passage does disclose of suggest that "content
descriptions transmitted from said remote processing location to said client location
include information specifying the beginning and ending time of each of said common
program segments" as set forth in claim 6. These comments also apply to claim 15 which
was rejected for the same reasons as claim 6.

*13.   As to claim 9, Schulhof discloses uploading a copy of a program segment stored locally
at said client location to said remote processing location (i.e., two-way communications; col. 5,
lines 9-12 and 52-53; col. 6, lines 31-39; col. 9, line 65 – col.
10, line 4).*

The cited passages describe the manner in which the client sends program
selection requests to the remote location, but nowhere suggests *uploading locally stored
program segments.*

*14.   As to claim 10, Schulhof discloses posting an entry upon the transmittal of the
identification data to the remote processing location, subsequently transmitting a playback
request identifying the client location and identifying a requested program
segment (col. 10, lines 52-65).*

*The cited passages describe the manner in which requests from multiple
subscribers for a single program segment in the library are grouped for more efficient
transmission. The cited passage does not describe the novel arrangement for
transmitting a given program segment to a client if and only if the client first
demonstrates that a copy was previously stored at the client location by transmitting*

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identification data for that

15.   *As to claims 14 and 18-20, Schulhof discloses displaying the program guide data for use at the client station to facilitate the selection and reproduction of desired ones of the particular programs (col. 5, lines 5-8).*

> The cited passage of Schulhof describes the manner in which the subscriber views a catalog of available programs transmitted via a data exchange channel. This guide describes the programming available that is available in the remote library, not programming segments that contain common segments which match the program segments already stored locally at the client location.

Conclusion

Reconsideration of the rejection of claims 1-10 and 13-20 and allowance of all claims is requested.

Respectfully submitted,

Dated: March 5, 2004   Charles G. Call, Reg. 20,406
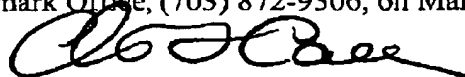
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